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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,369	02/07/2002	Hisashi Isaka	2002-0217A	7447

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/067,369	ISAKA, HISASHI	
	Examiner	Art Unit	
	Robert Sellers	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 and 30 January 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-14 and 16-26 is/are pending in the application.
 4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1, 3, 7-14 and 16-19 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

This action is a reiteration of the Final rejection mailed February 5, 2004 except for the consideration of the declaration filed January 30, 2004 which had not been received.

Claims 20-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the election filed August 1, 2003.

The 35 U.S.C. 112, second paragraph, rejection has been resolved by the definition of compound (a-2) as optional and the deletion of the tradenames from claim 3, lines 5 and 6. The 35 U.S.C. 102(b) and 103(a) rejections over the

Castell et al. and Mas et al. articles are rescinded in response to the limitation of the metal triflate to zinc triflate. However, Mas et al. remains applicable to the 35 U.S.C. 103(a) rejection involving PCT '055 based on the recitation of 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexane carboxylate as a polymerizable and crosslinkable oxirane.

The 35 U.S.C. 103(a) rejection over Kitabatake et al., Japanese '075 and Eaton et al. in view of PCT '087 and '055 and the Mas et al. and Castell et al. articles is withdrawn since the primary references set forth curing with carboxyl-functional polyesters (Kitabatake et al. and Japanese '075) or caprolactone polyols (Eaton et al.) which involve different curing means from the metal triflate curing mechanisms of the PCT patents and the Mas et al. and Castell et al. articles.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 7-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication No. WO 94/09055 in view of PCT Publication No. WO 00/08087 and the Mas et al. article.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed January 22, 2004 have been considered but are unpersuasive.

Mas et al. has a publication year of 2001. It is unclear whether Japanese priority applications 2001-31763 (February 8, 2001), 2001-53204 (February 27, 2001) and 2001-66440 (March 9, 2001) antedate the reference since the month and day of publication are not indicated in the abstract.

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Japanese '763 (page 4, lines 9-10) and Japanese '440 (page 4, line 9) only substantiate a composition wherein the amount of metal triflate is from 0.01-2 parts by weight as opposed to the claimed upper limit of 5 parts by weight (claim 16). Japanese '204 (page 4, lines 18-20) only supports the upper limit of 5 parts by weight when the composition contains water (claims 17-19). Accordingly, claims 1, 3 and 7-14 requiring as much as 5 parts by weight of zinc triflate without the affirmative inclusion of water is not accorded the earlier filing dates of the Japanese priority documents.

PCT '055 (page 4, lines 10-12) discloses the polymerization of oxiranes in the presence of zinc triflate. The claims are directed to a "curing" composition containing a polymerizable alicyclic polyepoxide which denotes the capability of the composition to be cured and not the cured composition itself. The polymerizable oxirane of PCT '055 present with the zinc triflate also possesses the capacity for curing.

There are no limitations to the quantitative functionality of the oxiranes of PCT '055. PCT '087 and Mas et al. teach the crosslinking of epoxy resins such as 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexane carboxylate in the presence of a lanthanide triflate. PCT '087 establishes the reaction of oxiranes in the presence of either the claimed zinc triflate or the lanthanide triflate of PCT '055. The combined disclosures of the prior art clearly espouse the polymerization and curability of oxiranes including 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexane carboxylate in the presence of zinc triflate.

The closest prior art of PCT '055 (pages 47-49, Example 66 and page 53, Example 77) shows the claimed zinc triflate. Example A-4 of Table A on page 3 of the declaration and Examples A-19, A-20 and A-21 of Table B on page 4 using ytterbium triflate are not representative of the closest prior art zinc triflate of PCT '055 which is the claimed species of catalyst. The issue with respect to PCT '055 is not the type of catalyst but is the obviousness polymerizing the claimed alicyclic polyepoxide over the closest prior art tetrahydrofuran exemplified in the reference.

Even if, arguendo, the data is considered, the evidence is not commensurate in scope with the claimed proportion range of from 0.01-5 parts by weight of zinc triflate which are orders of magnitude broader than the tested amounts of 0.2, 0.5, 1.0, 1.5 and 3 parts by weight [italicized to indicate newly added].

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT '087 and '055 in view of Kitabatake et al. Patent No. 6,369,133 and Japanese Patent No. 4-359075.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments address solely Mas et al. and Castell et al. which are no longer relied upon as primary references.

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The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

(571) 272-1093 (Fax no. (703) 872-9306)
Monday to Friday from 9:30 to 6:00 EST

Any administrative inquiries can be obtained by accessing the Patent Application Information Retrieval (PAIR) system. Published applications are available through either private or public PAIR. Unpublished applications are available via private PAIR only. Consult <http://pair-direct.uspto.gov> or contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712